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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWIN LYDA

Appeal 2008-0994
Application 09/920,961
Technology Center 2600

Decided: June 25, 2008

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1-7, 13-15, 17-21, and 23-25. Claims 8-12, 16, and 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellant's invention relates to a remote response system in which portable response devices are provided to users enabling users to input and transmit data over existing communication systems. A remote response device user can communicate with a presenter of broadcast programming in real time without requiring the use of a personal computer.

(Specification 2).

Claim 1 is illustrative of the invention and reads as follows:

1. An electronic response device other than a personal computer, the response device configured to allow a user to send data over a standard communication system in response to a program received apart from the response device, the response device comprising:

a user input mechanism for entry of user input and responses, the mechanism operating without receiving signals eliciting a response by the user;

means for requiring the user's input of a program identifier code for the program received apart from the response device;

means for providing a user identifier code, the means selected from the group consisting of having the user identifier code associated with the response device and having the user input the user identifier code;

a central processing unit (CPU) for correlating the responses the user has entered into the user input mechanism to the program identifier code and for processing the program identifier code, the user identifier code, and responses the user has entered into the user input mechanism;

a power source; and

a transmitter connected to the CPU.

The Examiner's Answer cites the following prior art references:

Lewis	US 5,303,042	Apr. 12, 1994
Yoshinobu	US 5,721,584	Feb. 24, 1998
Van Ee ¹	US 6,466,203 B2	Oct. 15, 2002 (filed Jul. 19, 2000)
Dobson	US 6,704,317 B1	Mar. 9, 2004 (filed May 27, 1998)
Ferris	WO 99/04568	Jan. 28, 1999

Claims 1, 2, 13-15, 17, 20, 21, and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ferris.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferris in view of Dobson.

Claims 4-6, 18, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferris alone.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferris in view of Yoshinobu.

Claims 19 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferris in view of Lewis.²

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to

¹ The Van Ee reference is not part of any stated ground of rejection but, rather, as indicated in the final Office action, is cited as evidence in support of the Examiner's rejection of claims 5 and 6.

² As indicated at page 3 of the Answer, the Examiner has withdrawn the 35 U.S.C. § 112, first paragraph, rejection of claims 1-7, 13-15, 17-21, and 23-25.

make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C. § 102(b), does Ferris have a disclosure which anticipates the invention set forth in claims 1, 2, 13-15, 17, 20, 21, and 23?
- (ii) Under 35 U.S.C. § 103(a), with respect to appealed claim 3, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Ferris with Dobson to render the claimed invention unpatentable?
- (iii) Under 35 U.S.C. § 103(a), with respect to appealed claims 4-6, 18, and 24, would one of ordinary skill in the art at the time of the invention have found the claimed invention obvious over the teachings of Ferris alone?
- (iv) Under 35 U.S.C. § 103(a), with respect to appealed claim 7, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Ferris with Yoshinobu to render the claimed invention unpatentable?
- (v) Under 35 U.S.C. § 103(a), with respect to appealed claims 19 and 25, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Ferris with Lewis to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

Claims 1 and 2

With respect to the 35 U.S.C. § 102(b) rejection of independent claim 1 based on the teachings of Ferris, the Examiner indicates (Ans. 3-8) how the various limitations are read on the disclosure of Ferris. In particular, the Examiner directs attention to the illustrations in Figures 3 and 4 of Ferris as well as the accompanying description beginning at page 10, line 18 of Ferris. Appellant’s arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Ferris so as to establish a *prima facie* case of anticipation.

After reviewing the Ferris reference in light of the arguments of record, we are in general agreement with Appellant’s position as stated in the Briefs. At the outset, however, we note that we do not agree with Appellant’s contention (App. Br. 10-12; Reply Br. 2-3) that the Examiner

erred in interpreting the claimed “input mechanism” as a keypad structure separate from a response device. As asserted by the Examiner (Ans. 13-14), Appellant’s disclosure, in particular, lines 1-4 at page 8 of the Specification and the language of original dependent claims 2-5, simply does not support the interpretation of the claim terminology “user input mechanism” urged by Appellant in the Briefs. We find no error in the Examiner’s finding that the separate keypad structure 622 of Ferris, illustrated in Figure 5 of Ferris, corresponds to the claimed “user input mechanism” since it operates “without receiving signals eliciting a response by the user” as claimed.

We do agree with Appellant (App. Br. 11; Reply Br. 4), however, that the Examiner erred in finding that Ferris discloses the required user input of a program identifier code for the program that is received apart from the response device 614 as set forth in appealed claim 1. Our review of the disclosure of Ferris reveals that the only embodiment examples in which a user enters an identifier code are those illustrated in Figures 2J and 2L of Ferris and discussed at page 27, lines 10-20 referenced by the Examiner. However, in neither of these instances is the user entering a code for a program that is received apart from the response device but, rather, is responding to response eliciting information on the response device itself.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Ferris, we do not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of appealed independent claim 1, nor of claim 2 dependent thereon.

Claims 13, 14, 17, 20, and 23

Although we found Appellant's arguments persuasive in convincing us of error in the Examiner's 35 U.S.C. § 102(b) rejection of claims 1 and 2, we reach the opposite conclusion with respect to the rejection of claims 13, 14, 17, 20, and 23. With respect to the claimed feature, in independent claims 13 and 20, requiring user input of a program identifier code, Appellant reiterates the argument (App. Br. 13-16; Reply Br. 4) made with respect to claim 1, i.e., Ferris does not provide for user input of a program identifier code for a program received apart from the response device.

We find, however, Appellant's argument to be not commensurate with the scope of claims 13 and 20. Unlike the language of claim 1, there is no requirement in claims 13 and 20 that the program for which a program identifier code is entered be received "apart from the response device." We make reference to the embodiment illustrated in Figure 2L of Ferris and discussed at page 27, lines 10-20 of Ferris, cited by the Examiner (Ans. 15), in which a user enters a product identification code which results in a display of program information for the entered identification code. While such displayed information apparently appears on the display of the response device, such an occurrence is not precluded by the language of claims 13 and 20.

With respect to the claimed limitation of a user input device which operates without eliciting a response by the user, we refer to our earlier discussion in which we found that the Examiner did not err in treating the claimed user input device, i.e., a keypad, as an entity separate from the response device. We further find no error in the Examiner's finding that the remaining elements of claims 13 and 20 are present in the disclosure of

Ferris. As disclosed by Ferris, an identifier code (HUUID) of the handset assigned to a user is provided, the user identification and program identification information is transmitted to a central location, and the user response and program information is correlated (Ferris, page 13, line 23, page 13, lines 18-27, and page 16, lines 14-19).

For all of the above reasons, since all of the claim limitations are present in the disclosure of Ferris, we sustain the Examiner's 35 U.S.C. § 102(b) rejection of appealed independent claims 13 and 20, as well as dependent claims 14, 17, and 23 not separately argued by Appellant.

Claims 15 and 21

We sustain the Examiner's 35 U.S.C. § 102(b) rejection, based on Ferris, of these claims as well. Appellant's arguments (App. Br. 14 and 16; Reply Br. 4) to the contrary notwithstanding, the Figure 2L example disclosed by Ferris at page 27, lines 10-20, at the very least, describes a program presenter providing a display of information in response to a remote query from a user.

35 U.S.C. § 103(a) REJECTIONS

The rejection of claim 3 based on Ferris in view of Dobson

This rejection is not sustained. The Examiner has added (Ans. 9) the teachings of Dobson to Ferris to address the data burst transmission feature of dependent claim 3. We find nothing in the disclosure of Dobson, however, which overcomes the innate deficiencies of Ferris in disclosing the claimed invention as set forth in base claim 1.

The rejection of claims 4-6, 18, and 24 based on Ferris alone

This rejection is also not sustained. With respect to dependent claims 4-6, the Examiner's line of reasoning (Ans. 9, 10, 18, and 19) with respect to the claimed telephone number and Internet protocol features does not overcome the previously discussed deficiencies of Ferris in disclosing the invention as set forth in base claim 1.

With respect to dependent claims 18 and 24, the Examiner's explanation regarding the use of different telephone numbers to contact different parties in Ferris does not address the specific language of dependent claims 18 and 24. It is apparent that the language of claims 18 and 24 does not merely require the use of different telephone numbers for different parties but, rather specifically requires the use of pre-assigned telephone numbers that are tied to particular user responses.

The rejection of claim 7 based on Ferris in view of Yoshinobu

This rejection is not sustained as well. The Examiner has added (Ans. 11) the teachings of Yoshinobu to Ferris to address the connection status indicator feature of dependent claim 7. We find nothing in the disclosure of Yoshinobu, however, which overcomes the innate deficiencies of Ferris in disclosing the claimed invention as set forth in base claim 1.

The rejection of claims 19 and 25 based on Ferris in view of Lewis

We sustain this rejection since Appellant's arguments do not convince us of any error in the Examiner's stated position (Ans. 12, 19, and 20). As set forth by the Examiner, Ferris discloses (page 25, third and fourth

paragraphs) that a user is required to log on to the keypad before inputting response data. While Appellant is correct (App. Br. 19-20; Reply Br. 5-6) that Ferris does not disclose a requirement that a user log-in to a remote computer system before inputting responses, it is Lewis that is applied by the Examiner for this teaching. Further, we find no error in the Examiner's finding that a skilled artisan would have recognized and appreciated that the remote computer log-in teachings of Lewis would have served as an obvious enhancement to the system of Ferris, at the very least, for facilitating the desire of Ferris (page 8, third paragraph) to log and track user interactions with the described system.

CONCLUSION

In summary, with respect to the Examiner's 35 U.S.C. § 102(b) rejections of appealed claims 1, 2, 13-15, 17, 20, 21, and 23, we have sustained the rejection of claims 13-15, 17, 20, 21, and 23 but have not sustained the rejection of claims 1 and 2. With respect to the Examiner's 35 U.S.C. § 103(a) rejections of appealed claims 3-7, 18, 19, 24, and 25, we have sustained the rejection of claims 19 and 25, but have not sustained the rejections of 3-7, 18, and 24. Accordingly, the Examiner's decision rejecting appealed claims 1-7, 13-15, 17-21, and 23-25 is affirmed-in-part.

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Application 09/920,961

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED-IN-PART

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